

REMARKS/ARGUMENTS

The Office Action of July 17, 2006, has been reviewed, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested. Claims 1-18 and 45-59 are pending. Claims 19-44 and 60-62 are canceled.

Personal Interview

Applicants appreciate the courtesies extended by Applicants' representatives during the personal interview conducted with Examiner Felton and Primary Examiner Patel on September 6, 2006. Applicants discussed the innovative features of the claimed invention and how they distinguish over the Debonnett reference. In addition, Examiners Felton and Patel recommended clarifying claim amendments that have now been incorporated into the independent claims.

Claim Amendments

Independent claims 1 and 45 have been amended to replace "environment" with "subsystem" to further clarify aspects of the various embodiments of the present invention. In addition, dependent claims 5-7, 10, 11, 13, 51 and 52 have been amended for consistency. No new matter has been added.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-18 and 45-59 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application No. 1001/0032139 to Debonnett ("Debonnett").

Debonnett appears to be directed to a system for Internet based payments, e.g., Cybermoney network. *See* Abstract. Debonnett's system purports to be predicated on an agnostic demand deposit and cash management account connectivity interface for payment and settlement of goods and services purchased over the Internet. *Id.* The network interface of Debonnett purports to provide for seamless connection to commercial/investment bank checking, savings, merchant or cash management accounts for payment. *Id.* As further illustrated by Figure 2 of Debonnett, customer 2C makes a transaction to buy goods from an Internet merchant. *See* paragraph [0024] of Debonnett. Further, according to back-office settlement procedures, customer account 2J is debited 2I and merchant account 2L is credited 2K. *See* paragraph [0025] of Debonnett.

Missing from the disclosure of Debonnett is any discussion directed to the various embodiments of the claimed invention. More specifically, Debonnett fails to disclose a system by which a provider bank effectuates international banking transactions for a plurality of customers of a client bank. An exemplary embodiment of the claimed invention is illustrated in Figure 2 of the instant application. For example, Figure 2 of Applicants' disclosure illustrates a client bank subsystem 122 is established within a provider bank 120 comprising a plurality of customer accounts 205 corresponding to the plurality of customers of the client bank 100, and a client bank subsystem processor 200 coupled to the plurality of accounts 205 and coupled to the client bank 100; and a provider bank subsystem 124 established within the provider bank 120, as supported by Figure 2 of the instant application. As supported by the specification of the instant application, the client bank 100 may be a smaller local bank without any infrastructure for providing its customers with international banking services, according to one exemplary

embodiment of the present invention. *See* paragraph [0022]. The claimed architecture is simply missing from the disclosure of Debonnett.

The Office Action purportedly rejects the pending claims under 35 U.S.C. § 103(a) as being allegedly unpatentable over Debonnett. However, the Office Action fails to apply the proper analysis as required by the MPEP.

By applying Debonnett under 35 U.S.C. § 103(a), the Office Action recognizes that there are deficiencies in the applied reference. However, the Office Action fails to identify the missing claim limitations of Debonnett and makes no mention of a statement of motivation, as required for a proper rejection under obviousness. Therefore, the Office Action has clearly failed to meet its burden.

In accordance with MPEP § 706.02(j), after indicating that the rejection is under 35 U.S.C. § 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, with reference to the relevant column or page number(s) and line number(s),
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this case, the Office Action has failed to meet any of the basic criteria and accordingly has failed to meet its initial burden.

Completely missing from the Office Action is the rigorous analysis required by *Graham v. John Deere Co.* See e.g., *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

As the remaining dependent claims encompass the limitations of independent claims, these claims should be allowed for at least the reasons stated above.

CONCLUSION

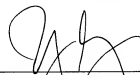
In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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